

## **REMARKS**

Claims 1-21, 27, and 28 were pending in this application. By this response, claim(s) 1, 5, 12, and 15 have been amended. New claims 29-32 have been added, and claims 2 and 28 have been cancelled. The amendments to the claims and the new claims are supported throughout the specification, and particularly in paragraphs [0010]-[0015], [0045], [0095]-[0096] and [0126]-[0128]. No new matter has been added. Cancellation or amendment of the claims is not to be considered a dedication to the public of any subject matter.

Thus, claims 1, 3-21, 27, and 29-32 are currently under consideration. Reconsideration of these claims is requested in view of the amendments and the following remarks.

### **Telephone Interview of October 2, 2008**

The Applicants thank the Examiner for the courtesy extended during the telephone interview of October 2, 2008. The Applicants have amended the claims in keeping with the agreement reached during this telephone interview. Applicants acknowledge that the Examiner will be issuing a summary of the telephone call.

### **35 U.S.C. § 102 Rejections**

#### **Claims 1, 2, 5-7, 9-12, 15-17, 19-21, 27, and 28**

Claims 1, 2, 5-7, 9-12, 15-17, 19-21, 27, and 28 currently stand rejected under 35 U.S.C. § 102(b) as being anticipated by Fox U.S. Patent Publication No. 2003/0050527 (“Fox”).

All of the Applicants’ pending claims recite features not taught or suggested by Fox. For example, the claims recite stimulation of the target from multiple positions so that the magnetic stimulation at the target is higher or greater than the magnetic stimulation at a region interposed between the target and the coil. As discussed during the telephone interview of October 2, 2008, Fox does not teach methods of stimulating that would concentrate the stimulation within the target structure rather than the regions interposed between the coil and the target, as taught and

claimed herein. Since Fox does not include all of the features recited in claims 1, 2, 5-7, 9-12, 15-17, 19-21, 27, and 28, Fox cannot anticipate them. The Applicants respectfully request withdrawal of the 35 U.S.C. §102(b) rejection of claims 1, 2, 5-7, 9-12, 15-17, 19-21, 27, and 28.

### **35 U.S.C. § 103 Rejections**

#### **Claims 3 and 13**

Claims 3 and 13 currently stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Fox U.S. Patent Publication No. 2003/0050527 in view of Muntermann, U.S. 6,461,289 (“Muntermann”).

As described briefly above, Fox does not teach or suggest all of the elements of claim 1. Furthermore, Muntermann cannot cure this deficiency. Muntermann describes the application of a magnetic field having both a constant and an alternating (frequency) component, but does not teach or even suggest applying magnetic energy so that the magnetic stimulation at the target is higher or greater than the magnetic stimulation at a region interposed between the target and the coil.

Since neither Fox nor Muntermann teach or suggest all of the elements of claims 3 and 13, these claims cannot be obvious over these references. The Applicants respectfully request withdrawal of the 35 U.S.C. §103(a) rejection of claims 3 and 13, and allowance of all of the pending claims for at least the reasons described above.

During the telephone interview of October 2, 2008, the Examiner also indicated that the Examiner would like the Applicants to further address the patentability of the pending claims over radiation therapies. As discussed during the interview, there are substantial, non-obvious differences between radiation therapy and the methods of Transcranial Electromagnetic Stimulation recited by the Applicants’ pending claims. In particular, methods of treating tissue with radiation are necessarily specific to the effects and interactions of radiation on the tissue. Transcranial Magnetic Stimulation of neuronal tissue results in very different timing and localization-specific effects. The pending claims recite steps which reflect the unique nature of Transcranial Magnetic Stimulation, and particularly steps which would not be obvious over references to radiation therapies. For example, the pending claims recite the step of applying magnetic stimulation (or applying current to a coil) at a frequency that is sufficient to prevent re-

polarization of the target as the coil is moved. This step would not be obvious to one of skill in the art seeking to merely apply the methods of radiation therapy to Transcranial Magnetic Stimulation. Thus, the Applicants feel that the currently pending claims are patentable over the prior art.

#### **Allowable Subject Matter**

Claims 4, 8, 14, and 18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicants thank the Examiner for indicating the allowable subject matter, but believe that, in light of the amendments and remarks made herein, all of the pending claims are currently allowable.

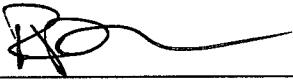
## **CONCLUSION**

In light of the remarks set forth above, Applicants respectfully request the Examiner expedite the prosecution of this patent application to issuance. If it is determined that a telephone conference would aid in the prosecution of this application, the Examiner is invited to telephone the undersigned at (650) 287-2164.

In the event the U.S. Patent and Trademark Office determines that an extension and/or other relief is required, Applicants petition for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 50-4050 referencing docket no. 10220-712.200. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Respectfully submitted,

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